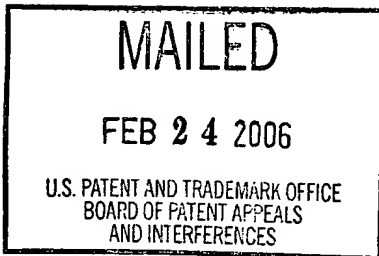


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DOMINIQUE BRIERE, LEON COISY, PAUL LA BARRE
and PASCAL SANTAIS



Appeal No. 2006-0123
Application ~~09/555,413~~

09/553,413

HEARD: JANUARY 26, 2006

Before OWENS, WALTZ and FRANKLIN, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from a rejection of claims 1-21 and 34-40.
Claims 15-21 and 34-40 were added by reissue.

THE INVENTION

The appellants claim a device and mold assembly for manufacturing molded thermoplastic containers. Claim 15, which claims the mold assembly, is illustrative:

15. A mold assembly for use in manufacturing molded thermoplastic containers comprising:

two mold shells each containing a half-impression of a substantial portion of the container to be molded;

two mold shell holders each defining a cavity for receiving each said respective mold shell such that each said respective mold shell is in at least partial mutual thermal-conduction contact with its respective shell holder, said shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures movable one with respect to the other; and

at least one quick-fixing locking member by which at least one of said mold shells is removably secured to a respective one of said mold shell holders, said one quick-fixing locking member including a selectively retractable locking member portion.

THE REJECTION

The claims stand rejected under 35 U.S.C. § 251 as follows: claims 1-21 and 34-40 as being based upon a defective reissue declaration, and claims 15-21 and 34-40 as being an improper recapture of subject matter surrendered during prosecution of the application for patent from which U.S. patent no. 5,968,560 issued.

OPINION

We affirm the rejection based upon the reissue declaration being defective and reverse the rejection based upon recapture.

*Rejection based upon the reissue
declaration being defective*

The appellants do not challenge the rejection based upon the reissue declaration being defective but, rather, state that they will provide a supplemental reissue declaration (brief, page 2). We therefore summarily affirm that rejection.

Rejection based upon recapture

Appendix C of the appellants' brief shows that to get the '560 patent issued the appellants amended claim 1 during prosecution to include, after "two mold carriers (3)", "which are made in the form of enveloping structures and", and that claim 1 of the issued '560 patent, which is the sole independent claim in that patent, includes that limitation. Appendix C also shows that claim 1 claims a device for manufacturing containers and that new claim 15 of the reissue application claims a mold assembly, i.e., a subcombination as opposed to the combination claimed in claim 1, and that claim 15 includes the limitation "said shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures". Since

claim 15 is a subcombination claim which claims only the mold assembly rather than the manufacturing device claimed in combination claim 1, claim 15 does not include the mold carriers but, rather, limits the shape of the shell holders to be supported by two mold carriers made in the form of enveloping structures. That limitation appears in each of the other new independent claims in the reissue application, i.e., claims 35, 36 and 39.

The examiner argues that the reissue claims are broader than the patent claims because the patent claims claim a combination which includes the mold carriers, whereas the reissue claims claim a subcombination which does not require the mold carriers (answer, pages 6-10). Thus, the examiner argues, the appellants are recapturing subject matter that does not require the mold carrier limitation. See *id.*¹

¹ The examiner also argues that "shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures" does not limit the structure of the shell holders because no shape is given to the shell holders in figure 1 of the '560 patent (answer, page 9). The examiner is incorrect because that claim language limits the shell holders structurally to shapes that they are capable of being supported by two mold carriers made in the form of enveloping structures.

The claim limitation added to get the '560 patent issued expressly limits the two mold carriers such that they are made in the form of enveloping structures, but also implicitly limits the shape of the shell holders to shapes that can be supported by such enveloping mold carriers. That limitation on the shape of the shell holders has been retained in the reissue claims to the mold assembly subcombination. The new reissue claims cannot include the mold carriers because the mold carriers are not part of the claimed mold assembly subcombination.

Thus, the appellants are not recapturing subject matter pertaining to the claimed mold assembly that was surrendered to get the '560 patent issued. Consequently, we reverse the examiner's rejection based upon recapture.

DECISION

The rejection under 35 U.S.C. § 251 of claims 1-21 and 34-40 as being based upon a defective reissue declaration is affirmed. The rejection of claims 15-21 and 34-40 under 35 U.S.C. § 251 as being an improper recapture of subject matter surrendered during prosecution of the application for patent from which U.S. patent no. 5,968,560 issued is reversed.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a)(1)(iv).

AFFIRMED

<i>Terry J. Owens</i>)	
TERRY J. OWENS)	
Administrative Patent Judge)	
)	
<i>Thomas A. Waltz</i>)	
THOMAS A. WALTZ)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	
<i>Beverly A. Franklin</i>)	INTERFERENCES
BEVERLY A. FRANKLIN)	
Administrative Patent Judge)	

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Application 09/553,413

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